

JFW



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/820,320	04/08/2004	Yi-Hsu Wu	TS01-1357B

000047390
 THOMAS, KAYDEN, HOSTEMEYER & RISLEY LLP
 100 GALLERIA PARKWAY
 SUITE 1750
 ATLANTA, GA 30339

CONFIRMATION NO. 8523

FORMALITIES LETTER



DC0000000016019034*



Date Mailed: 05/13/2005

NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has NOT been accorded to the above-identified application papers for the reason(s) indicated below.

All of the items noted below and a newly executed oath or declaration covering the items must be submitted within **TWO MONTHS** of the date of this Notice, unless otherwise indicated, or proceedings on the application will be terminated (37 CFR 1.53(e)). Replies should be mailed to: Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

The filing date will be the date of receipt of all items required below, unless otherwise indicated. Any assertions that the item(s) required below were submitted, or are not necessary for a filing date, must be by way of petition directed to the attention of the Office of Petitions accompanied by the \$400.00 petition fee (37 CFR 1.17(f)). If the petition states that the application is entitled to a filing date, a request for a refund of the petition fee may be included in the petition. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

- The application was deposited without drawings. 35 U.S.C. 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented." *Applicant should reconsider whether the drawings are necessary under 35 U.S.C. 113 (first sentence).*

Replies should be mailed to: Mail Stop Missing Parts
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

*A copy of this notice **MUST** be returned with the reply.*

Office of Initial Patent Examination (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



CERTIFICATE OF MAILING

I hereby certify that the below listed items are being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

**Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

on June 9, 2005.



Hui Chin Barnhill

In Re Application of:

Confirmation No.: 8523

Wu et al.

Group Art Unit: Unassigned

Serial No.: 10/820,320

Examiner: Unassigned

Filed: April 8, 2004

Docket No.: 252016-1921

For: **Whole Chip ESD Protection**

The following is a list of documents enclosed:

Return Postcard

Copy of Notice of Incomplete Nonprovisional Application

Petition Regarding Notice of Incomplete Nonprovisional Application

Tabs A, B, C

Copy of Formal Drawings (3 pages)

Further, the Commissioner is authorized to charge Deposit Account No. 20-0778 for any additional fees required. The Commissioner is requested to credit any excess fee paid to Deposit Account No. 20-0778.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Wu et al.

Serial No.: 10/820,320

Filed: April 8, 2004

Title: **Whole Chip ESD Protection**

Group Art Unit: Unassigned

Examiner: Unassigned

Confirmation No. 8523

TKHR Dkt: 252016-1921

TSMC Dkt: TS01-1357B

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Petitions; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 9, 2005.

A handwritten signature in black ink, appearing to read "Hui Chin Barnhill".

Signature – Hui Chin Barnhill
Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION
AND PETITION TO ACCORD THIS DIVISIONAL APPLICATION A FILING DATE
OF APRIL 8, 2004**

Sir:

On May 13, 2005 (over one year after the Applicant filed the above-referenced patent application), the Patent Office mailed a Notice of Incomplete Nonprovisional Application in the above-referenced patent application. The Undersigned respectfully submits that the Notice was mailed in error and as such should be withdrawn, and the original filing date of April 8, 2004 be granted.

With such a filing date, this application enjoys the priority benefit of the now-issued parent patent.

The Patent Office is hereby authorized to charge the \$400 for this petition fee to deposit account 20-0778. The Patent Office is further authorized to charge any additional fee that may be required to this same deposit account.

Request for Refund

Further to the information provided above, Applicants herein request a refund of the \$400.00 petition fee. Applicants assert that the misplacement of the formal drawings is an error by the USPTO, and not an error of the Applicants. Applicants assert that the necessary documents were included in the original filing of the above-referenced divisional application. Notwithstanding, the incorporation by reference of the parent application (made in the preliminary amendment filed in this case), effectively incorporated the content of these drawings into this application.

Respectfully submitted,

By: 
Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500

The Notice states that the application was deposited without drawings. Applicants disagree. Applicants assert that three pages of formal drawings were filed in the divisional application on April 8, 2004. Applicants have attached copies of the various documents to support this assertion.

Attached hereto (Tab A) is a photocopy of the return postcard that was filed with the original application in the above-referenced patent application. The postcard lists that 3 pages of drawings were included in the filing. As well, the USPTO has stamped the postcard, thereby confirming receipt of all documents listed.

Also attached hereto (at Tab B) is a photocopy of the certificate of express mail filed with the above-referenced patent application. Item 5 of this document states that new formal drawings were enclosed in the filing.

In addition to the foregoing, attached hereto (at Tab C) is a photocopy of the Preliminary Amendment filed with the above-referenced patent application, asserting that this application is a divisional of patent application 10/205,520 (now patent no. 6,879,203), and incorporating that application by reference. The drawings in the above-referenced divisional application are the same as those filed in the parent application, and therefore form part of the present specification (by virtue of the incorporation by reference).

It appears that the drawings were likely lost by the PTO, after receipt of the present application (not unlikely, as this application file was filed with the PTO more than one year before the PTO sent out this Notice). The undersigned has provided herewith a courtesy copy of these drawings, so that the PTO can supplement its files.

As the parent application has now issued, and in view of the foregoing facts, the undersigned hereby petitions the Patent Office to grant the original April 8, 2004, filing date.

Wu, et al.

Whole Chip ESD Protection

7501-1357B

4/9/04

Nov 16 2004

17548 U.S. PTO
10/820320



040804

EV385357329 US

Invention No. 1770
20 Spec. 12 Tot. Claims
8 claims
1 abstract
2 Drawings
2 Drawing 24

Patented By PTO